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| APPLICATION NO.   | FILING DATE        | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|--------------------|----------------------|--|------------------|
| 10/554,912  | 10/31/2005         | Hiroyuki Fukui       | Q91216   | 9744             |
| 65565<br>SUGHRUE-265550<br>2100 PENNSYLVANIA AVE. NW<br>WASHINGTON, DC 20037-3213 | 7590<br>01/14/2009 |                      | <div>EXAMINER</div> <div>JONES, MARCUS D</div> <div>ART UNIT</div> <div>PAPER NUMBER</div> <div>3714</div> <div>MAIL DATE</div> <div>DELIVERY MODE</div> |                  |
|   |                    |                      | 01/14/2009   | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/554,912

**Applicant(s)**

FUKUI ET AL.

**Examiner**

Marcus D. Jones

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/ISD) (See Paper No(s)/Mail Date 10/21 October 2008).  
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date: \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

The amendment filed on 29 September 2008 in response to the previous Non-Final Office Action (2 July 2008) is acknowledged and has been entered.

Claims 1-13 are currently pending.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1-3, 7-11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US PGPub 2005/0014548), and further in view of JP 2001-054612 (hereinafter JP '612).** (Rejection based on machine translation)

In reference to claims 1, 2, and 3, Thomas discloses: A gaming machine, comprising: a plurality of rotatable reels, each having an outer periphery on which a

plurality of symbols are provided (pg 1, par 5, *display with a plurality of mechanical reels*); and a cover body, formed with a plurality of observation windows, the cover body covering the reels such that the reels are selectively viewed through one of the observation windows in accordance with a condition of a game (pg 3, par 22, *mechanical display* and pg 3, par 28, *top box display*), further comprising: a first light source, disposed inside the reels to emit visible light; and a second light source, disposed outside the reels to emit ultraviolet light (pg 3, par 27 and see Figure 4, *leadlines 70 and 60 respectively*). Thomas does not specifically disclose first symbols visualized by visual light and symbols visualized by ultraviolet light. JP '612 teaches two kinds of patterns, one visible when ultraviolet light is on and one when ultraviolet light is turned off, one symbol is superimposed over the other. JP '612 also teaches that the symbols may be superimposed during a regular bonus game (see Figure 3 and par 16). Note that Thomas' top box display can be used to play bonus games (pg 3, par 28).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Thomas in view of JP '612 to increase the attractiveness of a gaming machine to attract more players.

In reference to claim 7, Thomas and JP '612 disclose the invention substantially as claimed. Thomas further discloses a special feature game (bonus game) that starts when a player transition from the base game is detected (pg 5, par 40).

In reference to claim 8, Thomas and JP '612 disclose the invention substantially as claimed. Thomas further discloses visual notification of transition to the special

feature game in the form of the Can't Lose .TM. symbol on a reel (see Figure 11 and pg 6, par 47)

In reference to claim 9, Thomas and JP '612 disclose the invention substantially as claimed. JP '612 further teaches that the ultraviolet light is turned on during the bonus game, which may be a lottery (par 16 and par 51).

In reference to claim 10, Thomas and JP '612 disclose the invention substantially as claimed. JP '612 further teaches a maximum number of bonus games (*casting lots*) to be played, the odds of winning the lottery and the predetermined pattern to win (par 36-37).

In reference to claim 11, Thomas and JP '612 disclose the invention substantially as claimed. JP '612 further teaches that the symbols visible by ultraviolet light are around the peripheral of the rotation reel and are in a blank state when the ultraviolet light is not on (par 17-18).

In reference to claim 13, Thomas and JP '612 disclose the invention substantially as claimed. Thomas further discloses superimposing a filter over a display (pg 2, par 15).

**4. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas and JP '612, and further in view of JP 2002-200243 (hereinafter JP '243).**  
(Rejection based on machine translation)

In reference to claim 4, Thomas and JP '612 disclose the invention substantially as claimed, but fails to disclose a mirror. JP '243 teaches a mirror, which provides a reflected image of the symbols (par 22).

It would have been obvious to a person having ordinary skill in the art at the time of the invention to have modified Thomas and JP '612 in view of JP '243 to add more paylines that increase player excitement.

In reference to claim 5, Thomas, JP '612, and JP '243 disclose the invention substantially as claimed, but fail to disclose a mirror. JP '243 further teaches a mirror position behind a display window (par 22). JP '243 also teaches the mirror maybe a half mirror reflecting symbols on the display device (par 25).

In reference to claim 6, Thomas, JP '612, and JP '243 disclose the invention substantially as claimed, but fail to disclose the first symbol as an inversion image. JP '243 further discloses that the image is reflected (*inverted*) onto the display device by the concave mirror (par 25).

**5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas and JP '612, and further in view of Schultz (US PGPub 2006/0205479).**

In reference to claim 12, Thomas and JP '612 disclose the invention substantially as claimed, but fail to teach that the reels spin in different directions. Schultz teaches that the reels spin from top-to-bottom in the base game and bottom-to-top in TPT (bonus) mode (pg 2, par 17).

It would have been obvious to a person having ordinary skill in the art at the time of the invention have modified Thomas and JP '612 in view of Schultz to make the game more appealing to the eye thereby increasing player excitement.

***Response to Arguments***

6. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcus D. Jones whose telephone number is (571)270-3773. The examiner can normally be reached on M-F 9-5 EST, Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John M. Hotaling can be reached on 571-272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marcus D. Jones/  
Examiner, Art Unit 3714

/John M Hotaling II/  
Supervisory Patent Examiner, Art  
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